Sherinna Nur Elena bt Abdullah v Kent Well Edar Sdn Bhd

HIGH COURT (KOTA KINABALU) — SUIT NO K22–187–2009-I
STEPHEN CHUNG JC
25 FEBRUARY 2011

Civil Procedure — Locus standi — What constituted locus standi — Photograph and images of claimant displayed on advertisements — Claim for injunction and damages — Whether claimant was rightful owner of photograph — Whether claimant had locus standi — Rules of the High Court 1980 O 33 r 2

Copyright — Infringement — Whether there was infringement — Claimant was a beauty queen before converting to Islam — Now sporting headscarf as part of religious practise — Photographs of claimant during days as beauty queen appearing on advertisements — Whether claimant's rights to privacy infringed — Whether claimant was rightful owner of photograph

The plaintiff was a beauty queen between the years of 1992–1994. However, she had converted to Islam in 1995 and as part of her religious practise, sported a headscarf. In 2008, the plaintiff discovered that her photographs and images appeared on the packaging of the defendant's products, particularly packages of rice being displayed and sold in various retail shops, grocery stores, supermarkets, hypermarkets and an advertisement board in Kota Kinabalu. The plaintiff thus averred that she had rights to privacy and claimed to be the rightful owner of the copyright of her own photograph and image and that the defendant had violated her rights to privacy and infringed the copyright. The plaintiff further submitted that she had been greatly injured in her credit, character and reputation by the defendant's flagrant disregard of her rights to privacy and claimed for an injunction, RM1m being the damages caused by the infringement and for exemplary or aggravated damages to be assessed. This was an application by the defendant pursuant to O 33 r 2 of the Rules of the High Court 1980 to determine whether the plaintiff had the locus standi to bring and maintain this action.

Held, allowing the application by the defendant and dismissing the plaintiff's claim with costs:

(1) The plaintiff was not the photographer or author of the photograph or image which was used by the defendant on its products. The plaintiff did not claim that she arranged or took or produced the photograph or image. If the plaintiff was the owner of the copyright by virtue of her

being in the photograph or image, then the other two women who also appeared in the photograph would also be the owners of the copyright in the photograph or image. However, they were not the parties to this suit and the plaintiff had not established that they have assigned their rights to her or have agreed to her to take up this suit against the defendant for infringement of the copyright purportedly jointly owned by them with the plaintiff (see para 17).

(2) The Sabah Tourism Board was the owner of the copyright or had the permission from the author or owner to publish the photograph or image in the book. That would effectively exclude the plaintiff to be the owner of the copyright and the right to sue for infringement of the copyright (see para 18).

(3) Neither the plaintiff nor the defendant had identified the photographer or author of the photograph or image. The plaintiff did not exhibit any agreement or affidavit or declaration to show that she had been assigned or licensed and was the owner of the copyright in the photograph or image to entitle her to sue the defendant for infringement of copyright (see para 19).

(4) Section 37(1) of the Copyright Act 1987 provides that infringements of copyright shall be actionable at the suit of the owner of the copyright. Since the plaintiff had not shown that she was the owner of the copyright in the photograph or image used by the defendant, she could not sue and had no locus standi to sue the defendant for infringements of the copyright (see para 20).

(5) Although the plaintiff was at liberty to sue the defendant for invasion of her privacy, however, the defendant did not intrude onto private property and took the photographs of the plaintiff without her consent. The photographs were taken many years ago by someone else at beauty pageants where she participated willingly as a contestant and in public. It was not a private affair on a private property. The photographs were also not offensive. The plaintiff did not complain then that she had been humiliated or ridiculed or was scandalised by the photograph or image (see para 26).

[Bahasa Malaysia summary

Plaintif adalah ratu cantik di antara tahun 1992-1994. Walau bagaimanapun, dia telah memeluk agama Islam pada tahun 1995 dan telah memakai tudung yang menjadi sebahagian tuntutan agamanya. Pada tahun 2008, plaintif mendapati bahawa fotonya dan imej tertera atas bungkusan barangan defendan, terutamanya paket-paket beras yang diatur susun dan dijual di pelbagai kedai runcit, kedai barang-barang runcit, pasaraya, pasaraya besar dan papan iklan di Kota Kinabalu. Plaintif oleh itu berhujah bahawa dia mempunyai hak kepada privasi dan menuntut sebagai tuan punya berhak

kepada hak cipta foto-fotonya dan imej sendiri dan bahawa defendan telah mencabul hak privasinya dan melanggar hak cipta. Plaintif selanjutnya berhujah bahawa kredit, peribadi dan reputasinya telah terjejas teruk oleh sikap tidak endah secara terang-terangan defendan terhadap hak kepada privasinya dan menuntut untuk injunksi, RM1 juta sebagai ganti rugi disebabkan oleh pelanggaran dan untuk ganti rugi teladan dan tambahan ditaksir. Ini adalah permohonan oleh defendan berikutan A 33 k 2 Kaedah-Kaedah Mahkamah Tinggi 1980 untuk menentukan sama ada plaintif mempunyai locus standi untuk membawa dan mengekalkan tindakan ini.

Diputuskan, membenarkan permohonan oleh defendan dan menolak tuntutan plaintif dengan kos:

(1) Plaintif bukan jurugambar atau orang yang mengambil photo atau imej yang digunakan oleh defendan atas barangannya. Plaintif tidak mendakwa dia yang menguruskan atau mengambil atau menerbitkan foto atau imej tersebut. Jika plaintif adalah pemilik hak cipta berikutan dia yang tertera dalam foto atau imej tersebut, oleh itu dua lagi wanita yang juga tertera di dalam foto juga akan menjadi pemilik hak cipta atau imej. Walau bagaimanapun, mereka bukan pihak di dalam tindakan ini dan plaintif tidak membuktikan yang mereka telah meletakkan hak mereka kepadanya atau bersetuju untuk mengambil tindakan ini terhadap defendan untuk pelanggaran hak cipta yang dianggap dimiliki bersama oleh mereka dengan plaintif (lihat perenggan 17).

(2) Lembaga Pelancongan Sabah adalah pemilik hak cipta atau mempunyai kebenaran untuk menerbitkan foto atau imej di dalam buku. Ini akan secara jelas mengecualikan plaintif menjadi pemilik hak cipta dan hak untuk menyaman untuk pelanggaran hak cipta (lihat perenggan 18).

(3) Kedua-dua plaintif dan defendan tidak mengenalpasti jurugambar atau orang yang mengambil foto atau imej. Plaintif tidak melampirkan apa-apa perjanjian atau afidavit atau deklarasi untuk menunjukkan yang dia telah diletakhakkan atau diberi lesen dan adalah pemilik hak cipta dalam foto atau imej untuk memberikan dia hak untuk menyaman defendan kerana pelanggaran hak cipta tersebut (lihat perenggan 19).

(4) Seksyen 37(1) Akta Hak Cipta 1987 memperuntukkan bahawa pelanggaran hak cipta boleh diambil tindakan oleh pemilik hak cipta. Memandangkan plaintif tidak menunjukkan yang dia adalah pemilik hak cipta di dalam foto atau imej yang digunakan oleh defendan, dia tidak boleh menyaman dan tiada locus standi untuk menyaman defendan untuk pelanggaran hak cipta (lihat perenggan 20).

(5) Walaupun plaintif bebas untuk menyaman defendan bagi pelanggaran privasinya, defendan bagaimanapun tidak menganggu ke atas harta persendirian dan mengambil foto plaintif tanpa kebenarannya. Foto

diambil beberapa tahun yang lalu oleh orang lain di pertandingan ratu cantik di mana dia telah mengambil bahagian dengan rela sebagai peserta dan di khalayak ramai. Ia bukan hal persendirian di tempat persendirian. Foto juga tidak provokatif. Plaintif tidak membuat aduan yang dia diaibkan atau diejek atau dimalukan dengan foto atau imej tersebut (lihat perenggan 26).]

Notes

For a case on what constituted locus standi, see 2(3) *Mallal's Digest* (4th Ed, 2012 Reissue) para 5629.

For cases on whether there was infringement, see 3(3) *Mallal's Digest* (4th Ed, 2013 Reissue) paras 7056–7057.

Cases referred to

Australian Broadcasting Corp v Lenah Game Meats Pty Ltd [2001] HCA 63, HC (refd)

Douglas v Hello! Ltd [2001] 2 WLR 992, CA (refd)

Federal Insurance Co v Nakano Singapore (Pte) Ltd [1992] 1 SLR 390, CA (refd)

Hellewell v Chief Constable of Derbyshire [1995] 1 WLR 804, QBD (refd)

Lee Ewe Poh v Dr Lim Teik Man & Anor [2011] 1 MLJ 835; [2010] 1 LNS 1162, HC (refd)

Maslinda bt Ishak v Mohd Tahir bin Osman & Ors [2009] 6 MLJ 826; [2009] 6 CLJ 653, CA (refd)

Mohd Ramly Ismail v Sarimah Film Production Sdn Bhd & Anor [1984] 1 CLJ 105, HC (refd)

OBG Ltd v Allan; Douglas v Hello! Ltd (No 3); Mainstream Properties v Young [2008] 1 AC 1, HL (refd)

Ultra Dimension Sdn Bhd v Ketua Pengarah, Lembaga Penggalakan Pelancongan Malaysia & Ors [2010] 8 CLJ 245, HC (refd)

Ultra Dimension Sdn Bhd v Kook Wei Kuan [2001] MLJU 751; [2004] 5 CLJ 285, HC (refd)

Legislation referred to

Copyright Act 1987 ss 7(1)(c), 10(1), 26, 37(1)

Rules of the High Court 1980 O 33 r 2

Suziana Saulkman (Mahap Jelani & Co) for the plaintiff.
Peter Lee (Lee & Associates) for the defendant.

Stephen Chung JC:

[1] This is an application by the defendant pursuant to O 33 r 2 of the Rules of the High Court 1980 to determine the question whether the plaintiff has the legal standing or locus standi to bring and maintain this action and upon the

question being determined in the negative for a consequential order that this action be dismissed with costs. The parties have agreed to proceed by way of affidavit evidence, there being no disputes of facts.

[2] The grounds of the application are that the copyright in the photograph of the plaintiff and of the image or print created belongs to the Unduk Ngadau Association of Kota Kinabalu who had organised the 'Unduk Ngadau' beauty pageant during the Harvest Festival in 1992 and to the photographer who was commissioned to take the photograph and create its image or print. They did not belong to or is not owned by the plaintiff.

[3] The facts of the case are as follows. The plaintiff now resides in Kuala Lumpur. Between 1992–1994, the plaintiff was a beauty queen. The plaintiff had won several beauty pageant titles in the State of Sabah, as the second runner-up for the 'Unduk Ngadau' beauty pageant held during the Harvest Festival in 1992 organised by the Unduk Ngadau Association in Kota Kinabalu, Sabah and as Miss Sabah China Town in 1992. The plaintiff also represented the State of Sabah as the Miss Sabah Universe Malaysia at the national level in 1993/1994 where the plaintiffs won several subsidiary titles.

[4] In November 2008, the plaintiff returned to Kota Kinabalu and discovered that her photographs and image appeared on the packaging of the defendant's products, particularly packages of rice being displayed and sold in various retail shops, grocery stores, supermarkets and hypermarkets in Kota Kinabalu. The plaintiff also discovered that her photograph and image on the defendant's packagings appeared on a large advertisement board located at Jalan Sentral Sepanggar/Sulaman, Kota Kinabalu, Sabah.

[5] The plaintiff avers that she has rights to privacy and is the rightful owner of the copyright of her own photograph and image. The plaintiff avers that she has never authorised nor granted any permission or license to the defendant to reproduce or to deal in any way whatsoever the plaintiff's photograph and image.

[6] The plaintiff avers that the defendant has violated her rights to privacy and infringed the copyright by reproducing and authorising, whether by the defendant themselves or by their servants or agents or otherwise howsoever, the reproduction, including publishing, advertising and printing of the plaintiff's photograph and image on the defendant's products and for the defendant's gainful and commercial purposes.

[7] The plaintiff avers that she was married in 1995 and converted to Islam. The plaintiff avers that she has decided to withdraw from the beauty pageant industry and as a Muslim she wears headscarf ('tudung') as her daily religious practice. The plaintiff avers that the defendant has violated her rights to her personal and religious values and principles and has also invaded her rights to publicity privacy.

[8] The plaintiff avers that she has been greatly injured in her credit, character and reputation by the defendant's flagrant disregard of her rights to privacy. The plaintiff has instructed her solicitors Messrs Mahap Jelani & Co to issue three notices of demand dated 14 April 2009, 19 May 2009 and 30 June 2009 respectively to the defendant demanding the defendant to remove the publication, advertisement and printing of the photograph or image of the plaintiff and demanding damages of RM1,000,000.

[9] The plaintiff files this action for an injunction, RM1,000,000 being damages caused by the infringement and for exemplary or aggravated damages to be assessed.

[10] The defendant denies any liability and avers that the copyright to all photographs taken of her and any print so created are owned by the organiser the Unduk Ngadau Association or the photographer who took them. Similarly, the copyright to all photographs taken of her in the Miss Sabah China Town and the Miss Sabah Universe Malaysia contests and any print so created are owned by their organisers or the photographers who took them respectively and not by the plaintiff as alleged or at all.

[11] In the further alternative, the defendant avers that if (which is denied) the copyright subsisted in the print in the defendant's packages and the advertisement board, the defendant does not admit to any infringement of any copyright because at the time the defendant was not aware and had no reasonable grounds for suspecting that any copyright subsisted in the print.

[12] The defendant avers that at all material times the defendant neither knew nor was acquainted with the plaintiff and had no knowledge of her personal and religious values and principles whatsoever as alleged.

[13] The defendant avers that the plaintiff has no rights to publicity privacy and privacy which are not known in Malaysian laws. As such, the defendant denies any invasion of those alleged rights. The defendant avers that the plaintiff lacks the locus standi to bring this action against the defendant.

[14] Order 33 r 2 provides that the court may order any question or issue arising in a cause or matter, whether of fact or law or partly of fact and partly of law, and whether raised by the pleadings or otherwise, to be tried before, at or after the trial of the cause or matter, and may give directions as to the manner in which the question or issue shall be stated. As a general rule the court will not exercise its power under O 33 r 2 to order a preliminary point of law to be tried whether or not that point involves the prior determination of factual disputes affecting that point, unless the trial of that issue will result in a substantial saving of time and costs in respect of the trial of the action: *Federal Insurance Co v Nakano Singapore (Pte) Ltd* [1992] 1 SLR 390.

[15] Section 7(1)(c) of the Copyright Act 1987 provides that artistic works shall be eligible for copyright. 'Artistic work' is defined in s 3 of the Act to mean (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality. Therefore a photograph or photographic image is eligible for copyright. Section 10(1) provides that copyright shall subsist in every work eligible for copyright of which the author or in the case of joint authorship, any of the authors is, at the time when the work is made, a qualified person. A 'qualified person' is defined in s 3 of the Act '(a) in relation to an individual, means a person who is a citizen of, or a permanent resident in, Malaysia; and (b) in relation to a body corporate, means a body corporate established in Malaysia and constituted or vested with legal personality under the laws of Malaysia'. And under s 3 of the Act, 'author' is defined as '(d) in relation to photographs, means the person by whom the arrangements for the taking of the photographs were undertaken'.

[16] Under copyright law, a person who creates a piece of work such as a poem, a play, a photograph or a painting is the author and usually the owner of the copyright in the piece of work. Where the piece of work is created within the scope of and in the course of his employment, the copyright vests in his employer subject to any contract affecting such ownership: see s 26 of the Copyright Act 1987. The burden is on the plaintiff to prove authorship in the photograph or image. To establish infringement of copyright, there must be two elements of sufficient objective similarity between the infringing work and the copyright work and that the copyright work must be the source from which the infringing work is derived: *Mohd Ramly Ismail v Sarimah Film Production Sdn Bhd & Anor* [1984] 1 CLJ 105.

[17] In the instant case, the plaintiff was not the photographer or author of the photograph or image which was used by the defendant on its products. The plaintiff did not claim that she arranged or took or produced the photograph or image. What she has said in her affidavits are that she verily believe that she is one of the three women shown in the photograph or image and she was advised by her solicitors and verily believe that she is the rightful owner of her

photograph or image which appeared on the defendant's packagings. If the plaintiff is the owner of the copyright by virtue of her being in the photograph or image, then the other two women will also be the owners of the copyright in the photograph or image. However they are not parties to this suit and the plaintiff has not established that they have assigned their rights to her or have agreed to her to take up this suit against the defendant for infringement of the copyright purportedly jointly owned by them with the plaintiff.

[18] The plaintiff has exhibited a letter from the Sabah Tourism Board to state that the board did not release the photograph or image which was published in a book by the board called 'Cultures, Customs and Traditions of Sabah, Malaysia An Introduction' in 1992 to any third party for any commercial purposes and did not receive any request or permission from anyone to use the photograph or image. This will implicitly mean that the board is the owner of the copyright or has the permission from the author or owner thereof to publish the photograph or image in the book. That would effectively exclude the plaintiff to be the owner of the copyright and the right to sue for infringement of the copyright.

[19] Neither the plaintiff nor the defendant has identified the photographer or author of the photograph or image used by the defendant, the plaintiff has not affirmed any affidavit to say that she has been assigned or owns the copyright to the photograph or image used by the defendant pursuant to an agreement with the photographer or author or owner or the Sabah Tourism Board and or the organisers of the various beauty pageants in which she took part during which the photograph or image was taken or produced. The plaintiff did not exhibit any such agreement or affidavit or declaration to show that she has been assigned or licensed and is the owner of the copyright in the photograph or image to entitle her to sue the defendant for infringement of copyright.

[20] Section 37(1) of the Act provides that infringements of copyright shall be actionable at the suit of the owner of the copyright. Since the plaintiff has not shown that she is the owner of the copyright in the photograph or image used by the defendant, she cannot sue and has no locus standi to sue the defendant for infringements of the copyright: see *Ultra Dimension Sdn Bhd v Ketua Pengarah, Lembaga Penggalakan Pelancongan Malaysia & Ors* [2010] 8 CLJ 245.

[21] Next it was submitted that privacy rights is not recognised under the English common law, citing the case of *Ultra Dimension Sdn Bhd v Kook Wei Kuan* [2001] MLJU 751; [2004] 5 CLJ 285 where it was held that English common law does not recognise privacy rights; therefore invasion of privacy rights does not give rise to a cause of action. However, that case went on to say

that there is an exception (at p 290), a cause of action may only arise if the photographs were highly offensive in nature and showed a person in an embarrassing position or pose and then (at p 292) that the photograph in that case was not a piece of confidential information as the appellant did not receive it from the respondent. English law has previously classified it as a breach of confidentiality between the intruder and the victim. In *Hellewell v Chief Constable of Derbyshire* [1995] 1 WLR 804, Laws J at p 807 said:

> If someone with a telephoto lens were to take from a distance and with no authority a picture of another engaged in some private act, his subsequent disclosure of the photograph would, in my judgment, as surely amount to a breach of confidence as if he had found or stolen a letter or diary in which the act was recounted and proceeded to publish it. In such a case, the law would protect what might reasonably be called a right of privacy, although the name accorded to the cause of action would be breach of confidence. It is, of course, elementary that, in all such cases, a defence based on the public interest would be available.

[22] In *Douglas v Hello! Ltd* [2001] 2 WLR 992, although the case was not pleaded and it was not decided on the question of invasion of privacy, Sedley LJ observed that 'what a concept of privacy does, however, is accord recognition to the fact that the law has to protect not only people whose trust has been abused but those who simply find themselves subjected to an unwanted intrusion into their personal lives. The law no longer needs to construct an artificial relationship of confidentiality between intruder and victim: it can recognise privacy itself as a legal principle drawn from the fundamental value of personal autonomy'. On appeal in related suits, the House of Lords decided the appeals on breach of contract and confidentiality and did not to extend the common law to include the tort of privacy: *OBG Ltd v Allan; Douglas v Hello! Ltd (No 3); Mainstream Properties v Young* [2008] 1 AC 1.

[23] Similarly, in *Australian Broadcasting Corp v Lenah Game Meats Pty Ltd* [2001] HCA 63 the High Court of Australia declined to declare that invasion of privacy is a new tort. Gleeson CJ said that the lack of precision of the concept of privacy is a reason for caution in declaring that it is a new tort and went on to say that certain kinds of information about a person, such as information relating to health, personal relationships, or finances, may be easy to identify as private; as may certain kinds of activity, which a reasonable person, applying contemporary standards of morals and behavior, would understand to be meant to be unobserved. The requirement that the disclosure or observation of information or conduct would be highly offensive to a reasonable person of ordinary sensibilities is in many circumstances a useful practical test of what is private.

[24] In Malaysia, the law on the invasion of privacy has developed since then. It is desirable especially in this internet era of Facebook and Youtube where lives

A can be destroyed by such unwanted invasion of privacy. The High Court at Penang allowed such a claim for invasion of privacy in the case of *Lee Ewe Poh v Dr Lim Teik Man & Anor* [2011] 1 MLJ 835; [2010] 1 LNS 1162 where it was held that a surgeon must obtain the consent of their female patients before taking photographs of their intimate parts during surgical procedures. B Although that case can be categorised as a breach of trust and confidentiality because of the doctor-patient relationship, the High Court expressly allowed the plaintiff's claim which, inter alia, pleaded an invasion of her rights to privacy.

C **[25]** I also refer to the case of *Maslinda bt Ishak v Mohd Tahir bin Osman & Ors* [2009] 6 MLJ 826; [2009] 6 CLJ 653. The appellant in that case was awarded damages for invasion of her privacy in the High Court. Although the appeal was on the issue of vicarious liability, the Court of Appeal did not overrule or reverse the High Court on the question of invasion of privacy. The D Court of Appeal in that case implicitly recognised the plaintiff's rights to privacy.

[26] Although the plaintiff is at liberty to sue the defendant for invasion of her privacy, in the instant case the defendant did not intrude onto private E property and took the photographs of the plaintiff without her consent. The photographs were taken many years ago by someone else at beauty pageants where she participated willingly as a contestant and in public. It was not a private affair on a private property. The photographs as exhibited were also not offensive. The plaintiff did not complain then that she had been humiliated or F ridiculed or scandalised by the photograph or image.

[27] From her affidavits, these pageants were reported and the photographs were published in the local newspapers. The particular photograph or image G which the plaintiff complained was an invasion of her privacy was also published in the book by the Sabah Tourism Board in 1992. It was reproduced by the defendant on its products. These photographs are in the public domain and cannot amount to an invasion of her privacy.

H **[28]** On the affidavit evidence before the court, to allow the action to proceed to trial will amount to an abuse of the process of the court. The court has an inherent jurisdiction to prevent an abuse of its process. For the reasons given the plaintiff's action is dismissed with costs to the defendant, if not agreed to be taxed.

I

Application by defendant allowed and plaintiff's claim dismissed with costs.

Reported by Afiq Mohamad Noor